

U.S. Application Serial No. 10/507,040
Atty. Docket No. 10191/3441
Reply to Office Action of July 28, 2009

REMARKS

Claim 26 is added, and therefore claims 10 to 26 are currently pending in the present application.

In view of the following, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

The Substitute Specification has been corrected to better align the text contained in the tables on page 7. In addition, table grid lines have been added to facilitate visual comprehension. The Examiner will also note the replacement of numerical values 126 and 15 in the table captioned, “List 1, newly initialized,” with new values 123 and 12, respectively. This replacement corrects an editing error and does not add new matter. Support for the amendments to the Substitute Specification may be found, for example, on page 7 lines 3 to 4 of the Substitute Specification, which states that the values 123 and 15 are reentered at instant 0 of the newly initialized list. Approval and entry are respectfully requested.

Claims 10 to 24 were rejected under 35 USC § 101 as directed to non-statutory subject matter.

According to the Office Action, the claimed invention is unsupported by a specific and substantial asserted utility. MPEP § 2107 makes clear that any rejection based on lack of utility should include a detailed explanation why the claimed invention has no specific and substantial credible utility. The Office Action has not provided any explanation as to why the claimed subject matter is not considered useful and therefore has not met this requirement. Instead, it has only been conclusorily asserted that utility has neither been asserted nor well-established in the art.

In any event, to facilitate matters, the Office’s attention is respectfully directed to page 6, line 32 to page 7, line 3 of the Substitute Specification, which describes the re-initialization of a list because of a maximum allowable number of list entries. Further, page 3, lines 10 to 16 discloses that the specific manner in which the list is re-initialized enables *continued tracking of an object*, e.g., including when the object is at a standstill, as well as enabling *analysis of an entire movement sequence*, while making *efficient use of memory* resources. In view of this explicit disclosure of various useful aspects of the claimed subject

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matter, it is respectfully submitted that a “specific and substantial utility” has been properly asserted. Withdrawal of the rejections is therefore respectfully requested.

Claims 10 to 24 were rejected under 35 USC § 112, first paragraph, as to the enablement requirement.

In view of the reasons explained above as to the utility of the subject matter in claims 10 to 24, it is respectfully submitted that the claimed subject matter has been shown to be useful, and therefore enabled--especially in view of the disclosure of the Substitute Specification.

As further regards the enablement rejections, it is respectfully submitted that the Office Action's assertions and arguments presented do not reflect the standard for determining whether a patent application complies with the enablement requirement that the specification describe how to make and use the invention -- which is defined by the claims. (See M.P.E.P. § 2164). The Supreme Court established the appropriate standard as whether any experimentation for practicing the invention was undue or unreasonable. (See M.P.E.P. § 2164.01 (citing Mineral Separation v. Hyde, 242 U.S. 261, 270 (1916); In re Wands, 858 F.2d. 731, 737, 8 U.S.P.Q.2d 1400, 1404 (Fed Cir. 1988))). Thus, it is axiomatic that the enablement test is “whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation.” (See id. (citing United States v. Teletronics, Inc., 857 F.2d 778, 785, 8 U.S.P.Q.2d 1217, 1223 (Fed. Cir. 1988))).

The Federal Circuit has made clear that there are many factors to be considered in determining whether a specification satisfies the enablement requirement, and that these factors include but are not limited to the following: the breadth of the claims; the nature of the invention; the state of the prior art; the level of ordinary skill; the level of predictability in the art; the amount of direction provided by the inventor; the existence of working examples; and the quantity of experimentation needed to make or use the invention based on the disclosure. (See id. (citing In re Wands, 858 F.2d at 737, 8 U.S.P.Q.2d at 1404 and 1407)). In this regard, the Federal Circuit has also stated that it is “improper to conclude that a disclosure is not enabling based on an analysis of only one of the above factors,” and that the examiner's analysis must therefore “consider all the evidence related to each of these factors”

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so that any nonenablement conclusion “must be based on the evidence as a whole.” (See M.P.E.P. § 2164.01).

Also, an examiner bears the initial burden of establishing why the “scope of protection provided by a claim is not adequately enabled by the disclosure.” (See id. (citing In re Wright, 999 F.2d 1557, 1562, 27 U.S.P.Q.2d 1510, 1513 (Fed. Cir. 1993))).

Accordingly, a specification that teaches the manner and process of making and using an invention in terms that correspond in scope to those used in describing and defining the claimed subject matter complies with the enablement requirement. (See id.).

In contrast to the above, however, it is respectfully submitted that the Final Office Action's unsupported assertions simply do not concern — as they must under the law — whether the present application enables a person having ordinary skill in the art to practice the claimed subject matter of the claims without undue experimentation — which it plainly does, as would be understood by a person having ordinary skill in the art in view of the disclosure of the present application, including the specification. In short, the Final Office Action's assertions are merely conclusory and do not address the issue of whether one having ordinary skill would have to unduly experiment to practice the claimed subject matter of the rejected claims — *a proposition for which the Office bears the burden of proving a prima facie case as to the rejected claims.*

In this regard, to properly establish enablement or non-enablement, the Office must make use of proper evidence, sound scientific reasoning and the established law. In the case of Ex Parte Reese, 40 U.S.P.Q.2d 1221 (Bd. Pat. App. & Int. 1996), a patent examiner rejected (under the first paragraph of section 112) application claims because they were based on an assertedly non-enabling disclosure, and was promptly reversed because the rejection was based only on the examiner's subjective belief that the specification was not enabling as to the claims. In particular, the examiner's subjective belief was simply not supported by any “evidence or sound scientific reasoning” and therefore ignored recent case law — which makes plain that an examiner (and not an applicant) bears the burden of persuasion on an enablement rejection.

More particularly, the examiner in Ex parte Reese was reversed because the rejection had only been based on a conclusory statement that the specification did not contain a sufficiently explicit disclosure to enable a person to practice the claimed invention without exercising undue experimentation — which the Board found to be merely a conclusory

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statement that only reflected the subjective and unsupported beliefs of a particular examiner and that was not supported by any proper evidence, facts or scientific reasoning. (See id.). Moreover, the Board made clear that it is “incumbent upon the Patent Office . . . to back up assertions of its own with acceptable evidence,” and also made clear that “[where an] examiner’s ‘Response to Argument’ is not supported by evidence, facts or sound scientific reasoning, [then an] examiner has not established a *prima facie* case of lack of enablement under 35 U.S.C. § 112, first paragraph.” (See id. at 1222 & 1223).

In the present case, the Office Action has not established – even in a conclusory way – that undue experimentation would be required. Moreover, even as to the assertions as presented, the present application plainly discloses how to use the subject matter of the rejected claims, as explained above.

Withdrawal of the enablement rejections is therefore respectfully requested.

Claim 25 was rejected under 35 USC § 103(a) as anticipated by U.S. Patent No. 5,554,983 (“Kitamura”) in view of U.S. Patent No. 7,436,887 (“Yeredor”), and further in view of U.S. Patent No. 5,966,074 (“Baxter”).

To reject a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Also, as clearly indicated by the Supreme Court in *KSR*, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. *See KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007). In this regard, the Supreme Court further noted that “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.*, at 1396. Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must

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teach or suggest all of the claim features. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

In rejecting claim 25, it appears that the Office Action has relied on the claim features of claim 10, which has not been rejected based on the applied references. The scope of claims 10 and 25 is not the same, as evidenced by their different specifically recited features, so that the Office Action's assertion that the applied references disclose the features of claim 10 is insufficient to establish a *prima facie* case of obviousness as to claim 25. However, to facilitate matters, the discussion below references the Office Action's assertions as to the applied references and the actual features of claim 25.

Claim 25, as presented, includes the feature of providing a respective list that describes a movement of the at least one object with respect to motion vectors and time. As to column 6, lines 1 to 36 and Figure 11 of Baxter, it is plainly apparent that the entries of the threads do not include motion vectors, but instead correspond only to x and y coordinate values which entries, if taken independently, do not provide any indication of motion. In contrast, the list entries shown in the tables on page 7 of the Substitute Specification include x and y values that correspond to motion vector values.

While the rejections may not be agreed with, to facilitate matters, claim 25 has been rewritten to provide that the list including an entry indicative of when the at least one object is at the standstill. As explained above, the thread entries of Baxter do not describe motion. Therefore, no entry is indicative of when the at least one object is at the standstill and Baxter does not disclose or suggest this additional feature, as provided for in the context of the presently claimed subject matter.

The Yeredor reference does not cure -- and is not asserted to cure -- the deficiencies of Kitamura as to the features discussed above as to the Baxter reference.

Accordingly, it is respectfully submitted that claim 25 is allowable, since Yeredor and Baxter do not cure the critical deficiencies of the primary Kitamura reference.

As further regards all of the obviousness rejections, any Official Notice is respectfully traversed to the extent that it is maintained and it is requested that the Examiner provide specific evidence to establish those assertions and/or contentions that may be supported by the Official Notices under 37 C.F.R. § 1.104(d)(2) or otherwise. In particular, it is respectfully requested that the Examiner provide an affidavit and/or that the Examiner provide published information concerning these assertions. This is because the § 103

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rejections are apparently being based on assertions that draw on facts within the personal knowledge of the Examiner, since no support was provided for these otherwise conclusory and unsupported assertions. (See also MPEP § 2144.03).

Withdrawal of the obviousness rejection of claim 25 is therefore respectfully requested.

New claim 26 does not add any new matter and it is supported by the present application, including the specification. Claim 26 depends from claim 10, as presented, and it is therefore allowable for essentially the same reasons, since claim 10 has not been rejected based on the applied references, and since the other non-art rejections of claim 10 have been obviated, as explained herein.

In sum, claims 10 to 26 are allowable.

CONCLUSION

In view of the foregoing, it is respectfully submitted that all of the presently pending claims are allowable. It is therefore respectfully requested that the rejections (and any objections) be withdrawn, since all issues raised have been addressed and obviated. An early and favorable action on the merits is therefore respectfully requested.

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By:

Gerard A. Messina
(Reg. No. 35,952)

KENYON & KENYON LLP
One Broadway
New York, New York 10004
(212) 425-7200

CUSTOMER NO. 26646

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